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Questions & Answers -- Copyright Column

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Endnotes

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2. Conde Nast Traveller™, *Top Ten Manhattan Hotels: The Library Hotel*, available at http://www.cntraveller.co.uk/topten/info/Manhattan_Hotels/Library_Hotel/default.html (Last visited October 8, 2003).
3. Fodors.com, *Rants & Raves: Rate Library Hotel*, available at http://fodors.com/rants/rrread.cfm?destination=new_york_city@111&class=Hotels@20003&entity_id=54060&property=LIBRARY%20HOTEL@267956&sort=name&pg=4 (Last visited October 8, 2003).
4. Michael Luo, *Where did Dewey file those law books?* New York Times, September 23, 2002, Late Edition-Final, Metropolitan Desk, p. B1; available at <http://www.norweld.lib.oh.us/norweldnews/viewer.asp?ID=2284> (last visited October 8, 2003).
5. I am purposely not using a ® or TM symbol here because I do not believe that the trademark claim is valid.
6. Mike Pramik, *Trademark Lawsuit: Hotel's use of library theme opens legal chapter*, Columbus (Ohio) Dispatch, September 20, 2003, Home Final Edition, p. 01A.
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9. 15 U.S.C. §1125(c)(1). Available at <http://www4.law.cornell.edu/uscode/15/1125.html> (last visited October 8, 2003).
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12. Samuel Trosow <strosow@uwo.ca>, *OCLC Complaint*, posting to law-lib-l@ucdavis.edu, September 24, 2003. Available at <http://lawlibrary.ucdavis.edu/LAWLIB/Sept03/0413.html> (last visited October 8, 2003). Trosow is quoting Quoting <http://www.bespacific.com/mt/resources/2003.09.22.hotel.pdf>.
13. *id.*
14. Kathy Thompson, *Dewey Decimal System Trademark Holder Sues Hotel for Using System as Decorating Theme—AU Trademark Law Expert Can Discuss*, AU News (American University), available at <http://domino.american.edu/AU/media/mediaref.nsf/0/c31699ee5bddf79e85256dac00703a92?OpenDocument> (Last visited October 8, 2003).
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17. Jason Schultz, *OCLC Sues Hotel Over Dewey Decimal System*, October 1, 2003. Available at <http://lawgeek.blogspot.com/> (Last visited October 8, 2003).
18. Dastar Corporation v. 20th Century Fox Film Corporation, 539 U.S. ____ (2003). Available at http://www.acm.org/usacm/PDF/Legal/Dastar_v_Twentieth_Century.pdf (Last visited October 7, 2003).
19. This information is taken directly from the Opinion of the Dastar Court.
20. Dastar at note 1.
21. 34 Fed. Appx. 312, 316 (2002).
22. 34 Fed. Appx. 312, 314. This language from the 9th Circuit was also quoted in the Supreme Court opinion.
23. This language comes from the Supreme Court decision, which is quoting the 9th Circuit opinion. The Supreme Court also referenced the Brief for Respondents 8, 11.
24. The page that Anderson is referencing is found at <http://www.uic.edu/depts/lib/reference/resources/uiccat/>. Rick Anderson <rickand@unr.edu>, *Dewey, The Library Hotel and U. Illinois*, posted to liblicense-l@lists.yale.edu, September 26, 2003. Available at <http://www.library.yale.edu/~llicense/ListArchives/0308/msg00277.html> (Last visited October 8, 2003).
25. Samuel Trosow <strosow@uwo.ca>, *Re: Dewey, The Library Hotel and U. Illinois*, posted to liblicense-l@lists.yale.edu, 27 Sep 2003. Available at <http://www.library.yale.edu/~llicense/ListArchives/0308/msg00277.html> (Last visited October 8, 2003).


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<http://www.oclc.org/dewey/versions/webdewey/>

<http://www.oclc.org/dewey/versions/abridgededition14/25>

Finally, OCLC has not gone after libraries that have used Dewey numbers without purchasing their DDC products. The selective nature of OCLC's enforcement is going to hurt their case considerably. On the other hand, if this lawsuit were successful, any library that did not join OCLC or a regional bibliographic utility or that did not purchase the DDC would not be able to use Dewey as their system. OCLC will have a difficult time in the courts with the idea of selective enforcement, and an even more difficult time in the profession with the idea of library enforcement.

Conclusion

OCLC's claim against the Library Hotel is based on trademarks in recent editions of the DDC. Yet the older issues were copyrighted rather than trademarked, and are currently in the public domain. The Dastar case speaks directly to this issue, stating that you can't use trademark enforcement to get around an expired copyright. OCLC also has difficulties in that it has not enforced the alleged trademark in the past, and is using selective enforcement in the present. Only time will tell whether OCLC will prevail; however, it is this author's belief that their case doesn't have a leg to stand on. Only time will tell. In the meantime, I'm thinking of making reservations at the Library Hotel for my next trip to New York. Even if they have to change their theme, it still sounds like a nice place to stay. And what more could you ask for in the greatest city in the world! 

Questions & Answers — Copyright Column

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QUESTION: *A library in a for-profit company owns issues of a journal title published prior to 1923 and wants to scan articles from these issues. May it do so without being concerned about copyright?*

ANSWER: Yes, if the journals were published in the United States before 1923, they are in the public domain. This means that anyone may reproduce the articles, even for public consumption. Thus, copying of these journals for the company library presents no copyright problem.

QUESTION: *How are international publications covered under US law? Are they protected?*

ANSWER: The first determination is what is meant by "international publications?" Are these publications by international organizations such as the United Nations or are they works published in a foreign country? If the work is published by the United Nations, any of its agencies or the Organization of American States, it is subject to protection under US copyright law according to section 104(b)(5) of the Copyright Act. Works by other international organizations are not subject to US copyright.

Foreign works are protected under US copyright if they are published in a country that is the party to a copyright treaty to which the United States is a signatory. See section 104(b)(2). This would include all of the signatory countries to the Berne Convention or any bilateral or multilateral treaty to which the United States is a party. Additionally, under section 104(b)(6), the President may by proclamation extend US copyright to works published in another country if that nation extends copyright to US authors on virtually the same basis as it extends to its own authors.

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QUESTION: For an email reference question, may a reference librarian copy and paste something from an online database into the response to the user?

ANSWER: The answer to this question is found in the license agreement that the library signed with the database vendor. If the reference question comes from a patron who is covered under the license agreement, then providing that user with material from that database is fine by cutting and pasting the material into the email answer to the reference question. If the inquiry comes from an outside patron who is not covered under the library's license agreement with the database vendor, then cutting and pasting would violate the terms of the license. The license agreement could contain a provision that permits use of material from the database for responding to reference questions by library staff members. Thus, under this condition, it would not be a violation of the license agreement to include material in any response to an email reference question. The basic answer to all of these questions is to check the license agreement.

QUESTION: What is the difference between the composer's rights and royalties and those of the music publishing company and recording company?

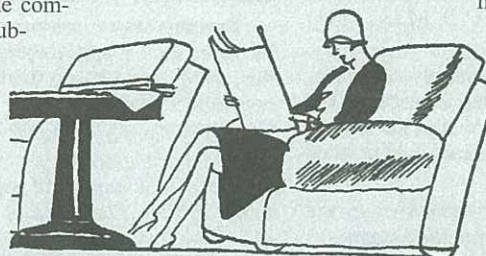
ANSWER: Under US copyright law, the copyright in a work initially vests with the author, i.e., the composer. The owner of the copyright is entitled to the exclusive rights provided under the Copyright Act: reproduction, distribution, adaptation, performance and display. If the work in question is a sound recording, the owner also has the right of public performance via digital transmission.

The composer usually transfers to the music publisher only the rights of reproduction and distribution of the composition. The publisher then collects royalties for sales of copies of the sheet music and pays a share of the royalties back to the composer. Generally, the composer retains all of the other rights such as public performance, so she continues to collect royalties for the public performance of her music.

A sound recording of the performance of a musical composition embodies at least two and sometimes three separate copyrights: the underlying musical composition, the recording of the performance of the music and a copyright in the arrangement of the music for the sound recording. The performer, who may or may not

be the composer, normally transfers the copyright in the performance of the music to the recording company that collects royalties for the sale of the recordings. The composer is compensated for the sale of recordings through the mechanical license, a compulsory license under the statute. The composer normally continues to own the copyright in the musical composition. When music is played on radio or television, royalties are paid to the composer in the form of a blanket license with the performance royalty organizations such as the **Association of Composers, Authors and Publishers (ASCAP)** and **Broadcast Music Inc. (BMI)**. There are no performance rights in sound recordings except for digital transmission. So, traditionally, the recording company makes its money from the sale of records and not from performance.

In 1995 and 1998 the Copyright Act was amended to provide public performance rights for sound recordings transmitted digitally. Thus, radio stations that Webcast now pay a second blanket license fee for performance royalties to the recording companies that may or may not share the proceeds with the recording artists. 🎧



Cases of Note

by **Bruce Strauch** (The Citadel) <strauchk@earthlink.net>

Copyright - Exhaustive Elvis Enjoined

Elvis Presley Enterprises, Inc., Jerry Lieber, Mike Stoller et al. v. Passport Video, a business of unknown form and origin et al., United States Court of Appeals for the Ninth Circuit, 2003 US App. LEXIS 22775 (2003).

Tallman, Circuit Judge: "The King is dead. His legacy, and those who wish to profit from it, remain very much alive."

Initially, I thought this judge was going to write in mock-tabloid language. But no. It's as dry as any other appellate holding.

Plaintiffs are companies that own copyright in various clips of **Elvis** appearances on **Ed Sullivan**, **Steve Allen** and the extremely Baroque *Elvis Aloha From Hawaii*. **Lieber** and **Stoller** are, of course, the famous Brill Building producers who hold copyright in his greatest hits such as *Jailhouse Rock* and *Hound Dog*.

Passport Video created a 16-hour life of **Elvis** called *The Definitive Elvis*. Since even the most rabid fan couldn't sit through sixteen hours, it was broken into one hour segments with such gripping titles as "The Army Years" and "The Spiritual Soul of Elvis."

The plaintiffs' clips are used throughout for a total of 5% to 10% of the new work. Nearly the entire **Steve Allen** appearance is used and 35% of the **Ed Sullivan**. Copyrighted photos

and, of course, the music is used throughout.

As to damages, the **Ed Sullivan Elvis** sells for \$10,000 per minute.

Plaintiffs got a preliminary injunction and this was appealed. A prelim injunc should not be issued unless they can show likelihood of success on the merits. Which is to say likelihood of overcoming **Passport's** fair use defense.

And, of course, there are no "bright line rules" to simplify things, but only the laborious "case-by-case analysis." *Los Angeles News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 938 (9th Cir. 2002). So let's drag ourselves through fair use once again.

Purpose and Character

Passport was in the business of making money and this tilts against fair use. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 US 539, 562 (1985); see also *Harper & Row*, 471 US at 562 ("The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.").

The defense to this is a "transformative" nature of the new **Elvis**. *Campbell v. Acuff-Rose Music, Inc.*, 510 US 569, 579 (1994). Is it su-

perseding the old work or adding something new through new expression, meaning, or message?

Monster Communications, Inc. v. Turner Broadcasting System, Inc., 935 F. Supp. 490, 493-94 (S.D.N.Y. 1996) held that the use of **Muhammad Ali** film clips in a commercial biography of the boxer was fair use because it constituted "a combination of comment, criticism, scholarship and research" concerning "a figure of legitimate public concern."

Hofheinz v. A&E Television Networks, 146 F. Supp. 2d 442, 444 (S.D.N.Y. 2001) found fair use in copyrighted clips of the actor **Peter Graves** again because it was transformative. "B" movie clips of **Graves** were used to demonstrate his humble beginnings in outdated, "campy" trash films.

Until he advanced to up-to-date, "campy" trash films.

The Ninth Circuit did not care for the fact that **Passport** advertised its video as containing "Every Film and Television Appearance." It was trying to profit by pulling together the TV appearances in one place without paying the customary fee.

Also, the use by **Passport** was not consistently transformative. Some are used only briefly

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